

**REMARKS**

Applicant has carefully studied the Final Office Action of March 10, 2004 and offers the following remarks to accompany the above amendments.

Applicant amends claims 1 and 27 to recite that the system determines if a parameter from the first IP telephony protocol maps to a parameter in the second IP telephony protocol, and that if the parameter does not map to the second IP telephony protocol that it is sent without alteration to the second protocol agent. This element can be found in previously presented claim 21. Applicant further amends claim 11 to recite that the second protocol is distinct from the first protocol. This was implicit in the claim as originally filed, but now is made explicit. As these elements have been previously presented, no new matter is added and no new issues are raised by these amendments, and a new search should not be required. MPEP § 904.

New claim 34 is added. Applicant encloses a credit card payment in the amount of \$104.00 reflecting the new independent claim and the additional claim over twenty.

Claims 1, 2, 4, 8-11, 13, 19, and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Salama et al. (hereinafter "Salama"). Applicant traverses. For the Patent Office to establish anticipation, the Patent Office must show where each and every element is located in the reference. Further, the elements of the reference must be arranged as claimed. MPEP § 2131.

The amendments to independent claim 1 to include the subject matter of claim 21 (which was not anticipated) mean that claim 1 is no longer anticipated. Dependent claims 2, 4, and 8-10 are likewise no longer anticipated.

Claim 11 has been amended to recite that the first IP telephony protocol is distinct from the second IP telephony protocol. Applicant appreciates the Patent Office's clarifying remarks on page 3 of the Office Action. In those remarks, the Patent Office specifically identifies the first IP telephony protocol as the H.323 protocol used by PX1 1434 to receive the call for 408 527 7147. The second IP telephony protocol is identified as the H.323 protocol used to transmit the message from PX1 1434 to PX2 1446. The Patent Office then identifies the third IP telephony protocol as SIP used to transmit the message from PX2 1446 to PX3 1658. As is readily apparent, the first and second IP telephony protocols are the same. The claim recites that the protocols must be distinct. To this extent, the reference does not show the recited claim element and cannot anticipate the claim.

Claims 13, 19, and 20 depend from claim 11 and are not anticipated at least for the same reasons.

In light of the amendments, Applicant requests withdrawal of the § 102(e) rejection of claims 1, 2, 4, 8-11, 13, 19, and 20 at this time.

Claims 5, 7, 14, 21, 27-30, 32, and 33 were rejected under 35 U.S.C. § 103 as being unpatentable over Salama. Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every claim element is located in the reference or in the combination of references. MPEP § 2143.03. When the Patent Office rejects a claim under § 103 as being obvious over a single reference, the Patent Office implicitly is admitting that the reference alone does not show all the elements, but that, in the Patent Office's opinion, there is some reason to modify the reference to include the missing element. To guard against impermissible hindsight reconstruction, the Federal Circuit has mandated that if the Patent Office desires to modify a reference, the Patent Office must articulate some reason to modify the reference. Further, the reason must be supported by actual evidence. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). If the Patent Office cannot provide the actual evidence, then the modification is improper and the Patent Office has not established *prima facie* obviousness. *Id.*

While the Patent Office does articulate motivations to modify Salama, the Patent Office does not provide the requisite actual evidence in the analysis of any of these claims. To this extent, the Patent Office has not established obviousness for any of these claims.

For example, with respect to claim 5, the Patent Office opines that because Q.931 is used, a skilled artisan would modify GW1 "so that in [sic] can also perform translation between Q.931 and H.323 to support connect IP telephony call when one of AS does not register with a GK." However, this is the sort of broad conclusory statement that the Federal Circuit prohibited in *Kotzab* and *Dembiczak*. There is no evidence that suggests that this modification is desirable or that someone would actually make the intellectual leap to make this modification. The Patent Office goes on to opine that "it would have been obvious to a person having ordinary skill in the art by the time the invention was made to made one of the IP telephony protocol is Q.931 in the system of figure 17." Again, this is the sort of broad conclusory statement that the Federal Circuit has prohibited. Nothing in the Patent Office's statement provides actual evidence that someone would make this intellectual leap to make this modification. Similar arguments exist

for the other claims. In the absence of actual evidence, the Patent Office is not allowed to modify the reference and, since the reference admittedly does not have all the elements without modification, the Patent Office has not established obviousness.

Claim 21 deserves special mention because the subject matter thereof is now incorporated into claims 1 and 27. With respect to claim 21, the Patent Office admits that Salama does not teach transmitting the call without performing translation. The Patent Office opines that an "AS in some cases connected to different ASes wherein each AS supports different IP telephony protocol. Therefore, a skilled artisan would have been motivated to modify the AS2 in figure 17 so that prior to perform the translation, determines whether the AS2 connects to a AS that can support H.323 and if that is the case forwarding the call through that path in order to avoid protocol differences." However, there is no provision in the reference to make such a determination, and as such, there is no way that such a modification is readily made. Even if the modification could be made without undue experimentation, there is no actual evidence to support the need to make the modification. Absent such evidence, the motivation to modify the reference is not proper. The Patent Office goes on to state "Therefore it would have been obvious to a person having ordinary skill in the art by the time the invention was made to determine whether to translate the call from H.323 to SIP, and transmitting the call without performing translation." It is unclear how avoiding protocol differences (i.e., determining whether the AS2 connects to an AS that can support H.323 to avoid protocol differences) supports a motivation to send a portion of the call without performing translation. In short, the Patent Office has not provided any actual evidence to support the modification to modify the reference, and thus, the Patent Office has improperly modified the reference. Since the reference may not properly be modified, the Patent Office has not established obviousness for the independent claims 1, 21, and 27, and the claims are allowable. The dependent claims are allowable at least for the same reasons. Applicant therefore requests withdrawal of the § 103 rejection of claims 5, 7, 14, 21, 27-30, 32, and 33 at this time.

Claims 3, 12, 15-18 and 31 were rejected under 35 U.S.C. § 103 as being unpatentable over Salama in view of Huitema et al. (hereinafter "Huitema"). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially notes that the Patent Office has not provided the requisite actual evidence to support the combination of Salama and Huitema. While the Patent Office opines

that modifications would be obvious and provides some analyses, each one of these analyses lacks any actual evidence. As such, these unsupported opinions are insufficient to support the combination and the references must be considered individually. The Patent Office admits that Salama alone does not teach or suggest all the claim elements. Likewise, the Patent Office has not shown where in Huitema all the claim elements are taught or suggested. Since the references cannot be considered in combination and the references individually do not show all the claim elements, the rejection fails and the claims are allowable.

Applicant further notes that even if the combination is proper, Huitema does not cure the deficiencies of Salama. Thus, even in combination, the references do not teach or suggest all the claim elements and the Patent Office has not established obviousness. Since the Patent Office has not established obviousness for multiple reasons, the claims are allowable. Applicant requests the withdrawal of the § 103 rejection of claims 3, 12, 15-18 and 31 at this time.

New claim 34 recites a software element that has an interworking protocol that works between at least three IP telephony protocols. Support for this can be found at page 13, lines 1-15 of the specification. The references of record do not teach a translation device that translates between three protocols in the manner claimed.

Applicant requests reconsideration of the rejection in light of the amendments and arguments. The Patent Office has not satisfied its burden in creating the obviousness rejections and cannot do so until the Patent Office provides the actual evidence as required by the Federal Circuit. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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MAY 10, 2004

Date of Transmission

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